

REMARKS

Claims 2-13, 15-20, 22-28, and 31-37 are pending.

Claims 1, 14, 21, and 29-30 have been cancelled.

Claim 38 has been added.

In the Office Action dated March 18, 2009, claims 1, 11-17, 21, 27-29 and 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,809,841 (Brewster) in view of U.S. Patent No. 5,930,350 (Johnson); claims 2-6, 18, 19, 22, 23 and 34-37 were rejected under 35 U.S.C. § 103(a) as unpatentable over Brewster in view of Johnson and further in view of U.S. Patent Publication No. 2002/0051206 (Masaki); claims 7-9, 20, 24, 25, 26, 31 and 32 were rejected under 35 U.S.C. § 103(a) as unpatentable over Brewster in view of Johnson and further in view of U.S. Patent No. 6,437,876 (Phang).

Independent claims 1, 14, 21 and 30, and dependent claim 29 have been cancelled, without prejudice.

Claim 7 has been amended from dependent form to independent form, by incorporating the subject matter of former independent claim 1. The scope of claim 7 has not been changed.

Claim 7 was rejected as purportedly obvious over Brewster, Johnson, and Phang. The Office Action conceded that Brewster and Johnson fails to disclose that formatting a page to be printed comprises checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins. 3/18/2009 Office Action at 11. Instead, the Office Action relied upon Phang as purportedly disclosing the claimed feature conceded to be missing from Brewster and Johnson.

It is respectfully submitted that the obviousness rejection of claim 7 over Brewster, Johnson, and Phang is defective.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as held by the U.S.

Supreme Court, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

Here, Phang fails to disclose or hint at the subject matter asserted by the Office Action to be taught by Phang. The Office Action cited column 1, lines 55-65, of Phang as purportedly disclosing the following:

wherein formatting a page to be printed comprises checking whether the accessed information for the formatted page fits between the document data areas and the printer allowable margins.

Column 1 of Phang refers to a work area on a page that is specified by a set of left, right, top and bottom margins. Phang, 1:40-41. Phang explains that a user can select these margins by specifying the distance of these margins from respective edges of a medium. *Id.*, 1:41-43. Phang also explains that in applications that allow extra information such as headers, footers, or line numbers to be included, the work area in such applications “is defined to cover the full extent of all the extra information added to a page.” *Id.*, 1:43-50. Phang states that if the work area falls within the printable area of the medium, the work produced in the work area can be printed completely on the medium. *Id.*, 1:50-52. However, Phang states that if the work area encroaches on the unprintable area, the part of the work which lies in the unprintable area will not be printed. *Id.*, 1:52-53.

Thus, according to Phang, an application verifies “user-selected margins with the reported boundaries [reported from a printer].” *Id.*, 1:62-64. In Phang, the checking that is performed is checking whether user-selected margins encroach and pass a boundary into an unprintable area of a medium. Determining whether user-selected margins exceeds a boundary that defines a printable area of a printer, as taught by Phang, is not the same as “checking whether the accessed information for the formatted page fits between the document data areas and the printer margins,” as recited in claim 7.

In fact, Phang assumes that extra information such as headers, footers, and line numbers are included within the work area defined by the user-selected margins. Thus, Phang would have absolutely no desirability or need to check whether accessed

information associated with a sender of document data can fit between document data areas and print allowable margins, since what Phang does is to check whether the entire work area as defined by user-selected margins are within printer boundaries, which is fundamentally quite different from the subject matter of claim 7.

Therefore, even if Brewster, Johnson, and Phang could be hypothetically combined, the hypothetical combination of the references would not have led to the claimed subject matter.

Moreover, it is respectfully submitted that a person of ordinary skill in the art would not have been prompted to combine these reference teachings, since the cited references disclose subject matter that are fundamentally different from the subject matter of claim 7. Phang would have taught a person of ordinary skill in the art to define a work area within user-selected margins, and then check whether such user-selected margins fit within printer boundaries. On the other hand, the subject matter of claim 7 relates to performing a different type of check, namely checking whether accessed information associated with a sender of document data fits between document data areas and printer allowable margins. Phang would not have prompted a person of ordinary skill in the art to combine the teachings of Brewster, Johnson, and Phang to achieve the claimed subject matter.

In view of the foregoing, it is respectfully submitted that the obviousness rejection of claim 7 is erroneous.

Dependent claim 20 has been amended from dependent form to independent form by incorporating former base claim 14. The substance and scope of claim 20 has not been changed. Similarly, claim 24 has been amended from dependent form to independent form by incorporating the subject matter of former independent claim 21, and dependent claim 31 has been amended from dependent form to independent form by incorporating the subject matter of former independent claim 30. Each of claims 20, 24, and 31 are non-obvious over Brewster, Johnson, and Phang for reasons similar to those stated above with respect to claim 7.

Independent claim 33 was rejected as purportedly obvious over Brewster, Johnson, Masaki, and Phang. With respect to claim 33, the Office Action conceded that

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Brewster, Johnson, and Masaki fail to disclose checking whether the formatted page fits between the document data areas and printer allowable margins. 3/18/2009 Office Action at 14. Instead, the Office Action relied upon Phang as purportedly disclosing the above claimed subject matter. However, as explained above in connection with claim 7, Phang fails to disclose or hint at this subject matter. Therefore, the obviousness rejection of claim 33 over Brewster, Johnson, Masaki, and Phang is also erroneous.

Dependent claims are allowable for at least the same reasons as corresponding independent claims. The rejections of dependent claims have also been overcome in view of the allowability of the base claims.

Allowance of all claims is respectfully requested.

The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (200901536-1).

Respectfully submitted,



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Dan C. Hu  
Registration No. 40,025  
TROP, PRUNER & HU, P.C.  
1616 South Voss Road, Suite 750  
Houston, TX 77057-2631  
Telephone: (713) 468-8880  
Facsimile: (713) 468-8883